
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Li-Jau Yang et al. Attorney Docket No.: CISCP584/334845
Application No.: 10/676,384 Examiner: Yogesh Paliwal
Filed: September 30, 2003 Group: 2435
Title: METHOD AND APPARATUS OF Confirmation No.: 9157
COMMUNICATING SECURITY/ENCRYPTION
INFORMATION TO A PHYSICAL LAYER
TRANSCEIVER

CERTIFICATE OF EFS-WEB TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically through EFS-WEB to Mail Stop Amendment, the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 on **January 23, 2009**.

Signed: _____ /Roger S. Sampson/ _____
Roger S. Sampson

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Restriction Requirement dated January 7, 2009, Applicant hereby elects, with traverse, species 1, claims 1, 7-11, and 17-20 to prosecute in the above-identified patent application.

The Restriction Requirement is respectfully traversed. The Office Action does not provide adequate reason for a restriction. In describing the burden of alleging a restriction, the MPEP notes: “A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.” (MPEP § 808.01.) Further, “the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation” the reason for the restriction. MPEP 808.02.

However, the Office Action provides inadequate reason for the restriction, stating only:

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph. (Office Action, p. 3.)

These statements merely reiterate the criteria of MPEP 808.02(A-C) without explanation or evidence regarding why any criterion would apply. The Office Action gives no indication why either alleged species would require a field of search any different from the other, that prior art applicable to one would not apply to the other, or that they raise different non-prior art issues.

Both species alleged by the Office Action claim “An apparatus for providing link layer security in a Physical Layer Transceiver (PHY).” Amendment D, pp. 2,4. The “mutually exclusive characteristics” identified by the examiner are only whether a Physical Layer Transceiver has a “crypto communication module configured to provide connectivity through a MDIO/MDC interface and also provide control signals to PHY” or a “PHY communication module … configured to provide connectivity through a MDIO/MDC interface and PHY controls the operation of crypto device”. Action, p. 2. These alleged differences in a PHY do not by themselves suggest any deviation from the general field of Physical Layer Transceiver art, nor do they suggest any significant subdivision within that field. The burden of explaining the reasons for the restriction remains unmet.

As such, the MPEP forbids restriction as separate species. “Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.” [MPEP 808.02] Therefore the restriction requirement is respectfully traversed.

If any fees are due in connection with the filing this Response to Restriction Requirement, the Commissioner is hereby authorized to charge such fees to Deposit Account 504480 (Order No. CISCP584).

Respectfully submitted,
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